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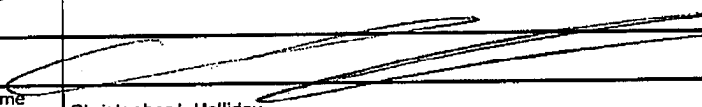
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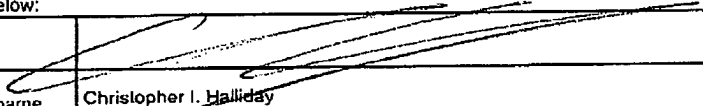
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TRANSMITTAL FORM <small>(to be used for all correspondence after initial filing)</small>	Application Number	09/922487	
	Filing Date	August 3, 2001	
	First Named Inventor	Halliday, Christopher I.	
	Art Unit	2155	
	Examiner Name	Bales, Kevin	
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: C. Halliday

Application No.: 09/922,487

Filed: August 3, 2001

FOR: Method and Apparatus for Selecting Satellite
Audio Radio Channels

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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) Group Art Unit: 2155
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) Examiner: Bates, Kevin
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REPLY BRIEF

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 30, 2007

APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 41.41

Appellant filed a Notice of Appeal in the above-identified patent application on May 9, 2007. Appellant filed an Appeal Brief on July 31, 2007. This Reply Brief responds to the arguments raised in the Examiner's Answer mailed October 12, 2007. This Reply Brief is being timely filed

I. Status of Claims

The rejection to the claims under 35 U.S.C. § 112, first paragraph, has been withdrawn.

Claims 41-43, 45, 47, 48, 50-53, 55-56, 58, 61-64, 74-77 and 81 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins, U.S. Patent No. 6,317,882, in view of Titlebaum et al., U.S. Patent No. 6,549,774, in further view of Owens et al., U.S. Patent No. 6,067,278.

Claims 46 and 57 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Brown. and Owens et al., in further view of Barton, U.S. Patent No. 6,233,389.

Claims 49, 59, 79, and 80 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Brown and Owens et al., in further view of Wall, U.S. Patent No. 6,055,244.

II. Grounds of Rejection to Be Reviewed

The claims stand rejected under 35 U.S.C. § 103.

Appellant respectfully maintains that the rejections under 35 U.S.C. § 103(a) are improper and should be reversed for all the reasons set forth in the appellant's Appeal Brief filed July 31, 2007.

Additionally, appellant further addresses points both clarified and newly raised by the Examiner in the Examiner's Answer.

As a preliminary matter, it should be noted that at the bottom of page 20 of the Appeal Brief, the last line should read, "each independent claim generally recites," as each claim could not easily be amended to specifically recite the exact same limitation and maintain grammatical sense. As clarified in the Appeal Brief, a single receiver is used to perform all receiver functions recited in the claim, which in turn is a patentable distinction of the claimed invention over the cited art.

III. Argument

The clarified rejections of the claims lacks merit because the rejections are unsupported by a rational basis and the Examiner's interpretation of the claims and cited art is unreasonable.

A. Whether the Rejections Under 35 U.S.C. § 103 Lack a Rational Basis and Are Therefore Improper

First, the Examiner's summary of appellant's basis for patentability of the claims is incomplete. Appellant is not merely arguing the combination of references cannot meet the limitations of the claims that allegedly describe a receiver that receives a plurality of stations, as written by the Examiner on page 18, lines 3 and 4 of the Examiner's Answer.

Rather, the claims are generally directed to a mobile, single receiver that receives a plurality of digital channels, and wherein the single receiver is used to save a designation of a work of authorship (e.g., title and/or artist, etc., as explained in the application), and wherein that single receiver is used to scan for the earlier saved designation while providing audio to a user. It is, at least, *the functional interrelationship* between all of the claim limitations that distinguishes the claimed invention over the cited art, where the cited art clearly requires multiple receivers in a receiving system. Here, it is clear that the Examiner has failed to consider the claimed invention as a whole, and instead conducted improper piecemeal examination.

Second, the Examiner's specific argument against patentability of the claims is merely a conclusory opinion unsupported by any factual findings. Specifically, according to the Examiner, the only actual difference between the device in element 802 of Robbins and the receiver claimed in the instant application is that "element 802 is named in Robbins as a receiving system while appellant wants to name his a single receiver" (see Page 18 of the Examiner's Answer, second sentence of the second paragraph).

However, in the present case, and as explained in the Appeal Brief, it is impossible for the Examiner to point to a single receiver in any of the cited art that performs all of the claimed receiver functions. For support, the Examiner points only to Robbins' "element 802," yet upon inspection, the Examiner's interpretation of 'element 802' is illogical and unreasonable because 'element 802' is, in fact, a combination of multiple receivers in a receiving system, and is not a single receiver within the reasonable meaning of the claimed invention, as explained below.

It is because (1) receiving system 802 is defined as multiple receivers in a system; (2) the overall conclusion of obviousness is not supported by substantial evidence; (3) the Examiner's interpretation of the terms of the claimed invention is objectively unreasonable; and (4) the claims provide un rebutted indicia of unobviousness, that the rejections should be reversed. Each point is explained further below.

1. Whether "Element 802" is a Main Receiver in Combination With One or More Auxiliary Receivers

To make the rejection under 35 U.S.C. § 103, the Examiner improperly considers the receiving system 802 to be within the scope of "a single receiver" of the claims without making any findings of fact to support such a conclusion. Appellant submits that the Examiner's characterization of the Robbins' "receiving system 802" as "a single receiver" defies logic and common sense, and appellant asserts that for the Examiner's "element 802" to meet all the limitations suggested by the Examiner, "element 802" must actually describe multiple, separate and distinct receivers.

First and foremost, even in an embodiment where the same stream type is received by the main receiver and is scanned by auxiliary receivers, Robbins teaches that the number of auxiliary receivers can be decreased, but that auxiliary receivers are still *required*, see, e.g. col. 35, lines 49-54 of Robbins, which states in part:

"The reduction in cost may be reflected in the decrease in the *needed* auxiliary receivers." (emphasis added)

Thus, even though the number of auxiliary receivers in Robbins may be decreased for the sake of cost at the expense of speed, one or more auxiliary receiver are still needed for Robbins' invention to function because under Robbins, only an auxiliary receiver scans.

It is also clear that Robbins teaches saving data from one stream type and scanning for that saved data on another stream type, and thus different receivers (each adapted to receive a different stream type), are required in such embodiments. Yet contrary to the Examiner's opinion concerning the differences between the claimed invention and Robbins (e.g., the second sentence of the second paragraph of page 18 of the Examiner's Answer) even when a single data stream is scanned, Robbins still requires auxiliary receivers, as explained in the preceding paragraph.

Thus, actual functional differences, more than in name only, exist between the claimed invention and the combination of cited art references.

Second, the Examiner has failed to present any finding of fact or rationale based on facts that supports the position that “a single receiver” of the claims can be interpreted as to encompass a receiving system of Robbins, or that the cited art provides, alone or in combination, a single receiver that, at least, (1) selectively saves user designated works of authorship, and also (2) scans for the user designated works of authorship while providing audio to a user. This is because there is nothing in the teachings of Robbins that would support the Examiner’s bald assertion that “receiving system 802” is a single receiver.

For example, the portion of the Robbins text relied upon by the Examiner for the rejection actually recites at col. 40, lines 10 to 14 of Robbins:

“As seen in FIG. 8(a), the receiving system 802, may include a main receiver 804 for receiving a spectrum of data streams that carry data signals; an auxiliary receiver 806 for scanning the spectrum of data streams; “ (emphasis added)

Based on at least the two preceding points, receiving system 802 is defined as a main receiver for receiving a spectrum of data streams *and*, an auxiliary receiver for scanning the spectrum of data streams. It is clear that the entire teaching of Robbins draws a bright line distinction between separate “receivers” (e.g., 804 and 806) and a “receiving system.” (e.g., 802) and that the single input 814 is split between main and auxiliary receivers.

Contrary to the Examiner’s opinion (see, e.g., the last two sentences of the second paragraph of page 18 of the Examiner’s Answer), appellant submits that the names in appellant’s claimed invention do not overlap with the names of receivers in the Robbins reference. This is because the claimed invention technically does not include either a main or an auxiliary receiver within the context of the teachings of Robbins. Specifically, in Robbins the terms “main” and “auxiliary” have a meaning that denotes a functional interrelationship between at least two receivers. Clearly, that type of relationship is completely absent from the claimed invention.

More specifically, the claimed invention includes a single receiver, which is technically neither “main” nor “auxiliary” to any other receiver, and the claimed single receiver performs all

the receiver functions recited in the claims. This is patentably distinct from the receiving system 802 of Robbins, where different functions are relegated to different dedicated receivers, as appellant has explained above and in the Appeal Brief.

Lastly, even if combined or modified in the manner suggested by the Examiner, the combination of references would then merely allegedly teach a main satellite audio radio receiver in combination with one or more auxiliary satellite audio radio receivers in a receiving system, which is again completely different than the claimed invention.

2. Whether The Examiner Has Failed to Support the Overall Conclusion of Obviousness With Substantial Evidence

Under the Examination Guidelines, which published before the mailing of the Examiner's Answer, the Patent Office indicates that there are seven rationales that can be used to find claims obvious, each of which must be supported by specific findings on the record to support a rejection. Here, the Examiner has not made any findings sufficient to support any of the rationales, much less show that the claimed invention is a predictable combination invention.

The Examiner's rejection is most clearly set forth in the last sentence of the first paragraph and second full paragraph on page 18 of the Examiner's Answer, where the Examiner relies on a citation to Robbins to describe receiving system 802. However, the text described in the Examiner's Answer is a mere fragment of a more complete sentence from the Robbins reference, which appellant clarified above. When the sentence is completed by reference to the actual teachings of column 40 of Robbins, and complete citations of text are understood, it is clear that in order to save ID codes and scan, Robbins' receiving system 802 requires at least a main receiver and at least one auxiliary receiver.

By simply opining that "receiving system 802" meets the claimed limitation of "a single receiver," the Examiner is improperly picking and choosing from the reference only so much as to support the rejection without reference to the actual teachings of the reference as a whole. At best, the Examiner points to the teachings of Robbins and states that receiving system 802, meets the broadest definition of "a single receiver." However, in so doing the Examiner ignores the fact that for saving and scanning to occur, the Examiner's element 802 (i.e., receiving system 802) is not a single receiver at all, but rather a system comprising at least: (1) a main receiver

(e.g., main receiver 804) for selectively saving information, and (2) an auxiliary receiver (e.g., auxiliary receiver 806) which scans.

The Examiner also improperly equates the single receiver of the claims and a receiving system in Robbins, while providing no factual findings to support *why or how* a person having ordinary skill in the art could have considered a receiving system having multiple receivers as a single receiver, as explained above in Section II.A.1., much less provide findings supportive of a reasonable expectation of success, as explained in the Appeal Brief.

Thus, one of many patentably distinct differences between the presently claimed invention and the combination of cited references is that the claimed invention accomplishes with a single satellite audio radio receiver (i.e., free of any auxiliary receivers) that which previously required two or more types of receivers arranged in a system, where each type had dedicated functionality. Accordingly, based on the evidence provided in the cited art, Appellant submits that at least a patentable distinction between receiving system 802 and the claimed invention exists, and it is the Examiner, not appellant, who is improperly renaming terms by construing receiving system 802 as describing a “a single receiver.”

Accordingly, no evidence, much less substantial evidence, supports the Examiner’s conclusory statement that the receiving system 802 is, or can be, considered by one of ordinary skill in the art as within the scope of the claimed “single receiver.” In the absence of any support in the record for the Examiner’s position, the rejection is unreasonable and should be reversed at the very least because the combination of cited references fails to arrive at the claimed invention.

3. Whether the Examiner’s Interpretation of the “Single Receiver” of the Claims is Objectively Unreasonable

As described above, appellant submits the Examiner is renaming terms by construing the receiving system 802 as “a single receiver” and appellant has presented argument, based on substantial evidence provided in the cited art, that one of skill in the art would not consider a receiving system of Robbins to be within the scope of the claimed “a single receiver.”

However, it is also objectively unreasonable for a person of ordinary skill in the art to consider “a single receiver” to encompass a system of receivers. This can be shown because use of the term “single receiver” has already been accepted by the Patent Office.

For example, the abstract of U.S. Patent No. 6,798,336 (the '336 patent), filed on July 11, 2001, recites (in part):

"In a remote vehicle door control, a single receiver is used..." (emphasis added)

Moreover, the Background and Summary of the '336 patent recites at col. 2, lines 10 to 19:

"However, the electronic control device in the vehicle must have separate receivers for receiving wireless signals for wireless control and smart entry control from the electronic key. This tends to cause an increase in device size and cost.

SUMMARY OF THE INVENTION

It is therefore an object of the present invention to provide an electronic control device which enables a single receiver to be shared for wireless control and a smart control." (emphasis added)

As in the present case, by virtue of antecedent basis and explicit limitation, the '336 patent patentably distinguishes itself from the art by, at least, limiting the invention to a single receiver. Additionally, a quick search of the USPTO database indicates that twenty (20) issued U.S. patents recite "single receiver" in the title field and one hundred and ninety six (196) issued U.S. patents recite "single receiver" in the claims.

Clearly, the Examiner's opinion that the "system of receivers 802" meets the presently claimed "single receiver" is objectively unreasonable because the art recognizes a clear distinction between the term "single receiver" and a group of receivers combined in a system where each receiver in the system has a specific function.

Accordingly, the claimed single receiver is patentably distinct over a receiving system (such as receiving system 802 of Robbins), alone or in combination with other cited references. With respect to the instant claimed invention, it is because the Examiner's interpretation of "single receiver" is unreasonable for at least all of the reasons set forth above, and because appellant has shown that at least in the context of scanning for an audio work of authorship, Robbins teaches away from the claimed invention, as described in the Appeal Brief and set forth briefly below, the claimed invention is patentably distinct from the cited art.

4. Whether the Claims Provide Indicia of Unobviousness

Appellant asserts that the claims are unobvious for all of the reasons provided in the Appeal Brief. However, given the clarification of the Examiner's rejection, it is important to point out again that the claims themselves provide indicia of unobviousness. Under the rules set forth in the MPEP at § 2144.04(II)(B), the claimed invention provides unrebutted indicia of unobvious because, generally, Robbins' required feature of one or more auxiliary receivers that scan for ID codes is omitted, while appellant's invention retains the omitted features function. Specifically, the claimed invention omits the requirement of at least one auxiliary receiver, yet retains the scanning function of the omitted element and also obtains, at least, the advantages described in the application. See, e.g., *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966).

For the Examiner to allege, without supportive findings, that when Robbins' receiving system 802, which includes at least a main receiver (804) and auxiliary receiver (806), is combined with the other cited references that the claimed invention is a predictable combination, the Examiner necessarily ignores established case law, the published Examination Guidelines, as well as the rules clearly set forth in the M.P.E.P.

Moreover, at the time of the invention, for at least the reasons set forth on page 27 of the Appeal Brief, to one of ordinary skill in the art Robbins teaches away from eliminating all auxiliary receivers or considering an auxiliary receiver alone in a vacuum or even considering the consolidation of a main receiver and auxiliary receiver(s) together into one receiver because (1) the use of a plurality of auxiliary receivers in combination with a main receiver is explicitly stated as providing superior results relative to a single auxiliary receiver in combination with a main receiver (even in the relatively simple embodiment of Robbins) and because different stream types can be scanned using different types of auxiliary receivers, (2) Robbins *requires* at least one auxiliary receiver *in combination with* a main receiver in a receiving system to function as intended, and (3) Robbins does not disclose or suggest that the objectives of the Robbins, invention can be met, even in an inferior manner, in the absence of either a main or auxiliary receiver. Lastly, the Examiner has failed to make any findings contrary to the foregoing, as required under the Examination Guidelines.

Accordingly, the claims provide unrebutted indicia of unobviousness, and are thusly allowable.

B. The Rejection of Claim 77 Lacks a Well Reasoned Basis

The distinction is made even clearer in dependent claim 77, which further requires receiving one or more signals from a terrestrial repeater on the same single receiver that receives one or more satellite radio signals.

According to the Examiner's Answer at page 18, first sentence of the second paragraph, "the receiving system receives a single input (814) and performs the steps of decoding..." However, the single receiver of claim 77 does not receive a single signal input, but rather receives at least two inputs. In claim 77, it is clear that at least two signals are received by the same single receiver - at least one input originating from at least one satellite, and at least one input of terrestrial origin. Thus, claim 77 is also patentably distinct from the combination of cited art, completely independent of any arguments concerning the parent claim.

C. The Rejection of Claims 43, 52, 74, and 76 Lack Any Well Reasoned Basis

Appellant submits that the basis for rejecting claims 43, 52, 74, and 76 lacks a well reasoned basis because the Examiner picks and chooses only so much of the teachings of Robbins that allegedly may support the rejection, without taking into account the actual teachings of the reference.

Specifically, the claims are directed to alerting a user to an audio stream. In making the rejection, which was repeated in the Examiner's Reply Brief, the Examiner indicated Robbins teaches "take any action to alert... to remember to watch the program" (emphasis added), i.e., the Examiner is citing a video stream and makes no references to findings that equate a video stream with an audio stream. This is particularly relevant, because video streams require significantly more data and can include tags or other indicia of works of authorship in the video data, as explained in Robbins at col. 39, lines 42 to 52. Here, the Examiner has not explained why or how one of ordinary skill in the art would remove data to convert the video stream of the reference into an audio stream of the claimed invention, without first destroying the intended function of the referenced teachings.

D. Whether the Examiner Has Engaged in Improper Burden Shifting

According to the Examiner, to distinguish the claimed invention appellant must show that a plurality of stations are not decoded by more than one decoder, but such claim language is "simply not supported by the specification."

It is because the primary Robbins reference fails to show a "decoder" and because the root "decode" or any variant of that root (e.g., decoder, decoding, decoded, etc.) is completely absent from Robbins, and because the Examiner has not provided any findings, rationale or showing to the contrary, that appellant submits that the Examiner is improperly shifting the burden to appellant to distinguish the claims over non-existent teachings.

Because the Examiner is, essentially, requiring appellant to reject his own claims, appellant disagrees with the Examiner and asserts that the pending claims are patentable for all of the reasons set forth herein and in the Appeal Brief, and allowance of the claims is earnestly solicited.

Moreover, appellant submits that the instant specification does in fact support the Examiner's newly suggested, patentably distinct feature for certain narrower embodiments which are unclaimed in, but potentially within the scope of, the present case, as explained in the preliminary amendment filed on November 16, 2007, in application serial no. 11/805,430, which is a continuation of the present application.


E. Conclusion

For all the reasons set forth above and in the absence of any factual findings, per at least the Examination Guidelines, the Examiner has failed to establish any rationale supported by the facts to show the rejected claims are obvious. In view of the foregoing, Appellant respectfully requests reversal of the Examiner's rejections and the allowance of the pending claims.

Respectfully Submitted,

Date: Nov. 30, 2007

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